

FILE COPY

Office - Supreme Court, U. S.
FILED

AUG 21 1948

CHARLES ELMORE CRUPLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1948.

No. 162

EXCEL AUTO RADIATOR COMPANY,
Petitioner,

vs.

THE BISHOP AND BABCOCK MANUFACTURING
COMPANY,
Respondent.

**PETITIONER'S COMMENTS RE INACCURACIES IN
RESPONDENT'S BRIEF.**

✓
MAX W. ZABEL,
FOSTER YORK,
Counsel for Petitioner.

IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1948.

No. 162.

EXCEL AUTO RADIATOR COMPANY,
Petitioner,

vs.

THE BISHOP AND BABCOCK MANUFACTURING
COMPANY,
Respondent.

**PETITIONER'S COMMENTS RE INACCURACIES IN
RESPONDENT'S BRIEF.**

The misleading character of Respondent's Brief forces us to further burden the Court by calling attention to a few of the more glaring inaccuracies, feeling that this Court will by its own study of the case be able to appraise the remainder.

Respondent's Brief, p. 13, last paragraph, to the effect that the second decision by the Court of Customs and Patent Appeals did not nullify its prior ruling of prior inventorship in Mayo is a peculiar claim in view of the ruling by the Circuit Court of Appeals that it did (R. 460, lines 3 to 8). Please see the quotation to that effect in the last three lines of our brief, p. 15.

Re page 12 of Respondent's Brief to the effect that our statement re "three technically informed tribunals" must be taken "with a grain of salt" because, as claimed by

Respondent, these decisions merely say that "even taking the Sperry story as true, he cannot prevail".

Such a claim is utterly unfounded in any fact basis, as the Examiner of Interferences could not have awarded Sperry a "conception" in 1935 except on the basis of the existence of the Sperry devices in 1935. There is nothing such as "even taking—etc." in any of those six prior decisions, but there is the definite ruling of conception in 1935. The Interference Examiner in the very *first* of these six decisions on which we rely says:

"The testimony with respect to Sperry Exhibits 2 and 3 is not of a very satisfactory character in several respects but *it is deemed sufficient to establish the assembly* of these two exhibits in cooperative relation at least by the end of October, 1935." (Emphasis ours.) (R. 328, middle paragraph.)

That finding is part of all of these six decisions. Please see pp. 14 and 15 of our brief giving record designations.

Respondent, p. 11, says that there is no finding of fact that "Sperry constructed various embodiments of the device in suit in the year 1935". There is no finding of fact by the *Circuit Court of Appeals* to that effect, but six other tribunals have found to that effect. The Circuit Court of Appeals ruled out as irrelevant and immaterial (not incompetent) the very evidence (the second interference series) which brought about the reversal by the Court of Customs and Patent Appeals, and this despite stipulation with regard thereto. (Please see par. 6, R. 19.)

Re second paragraph, p. 9, of Respondent's Brief, we wonder what is meant by saying that Petitioner did not offer this "additional evidence" (the evidence referred to in the preceding paragraph). Why was it necessary for the Circuit Court of Appeals to rule it out as immaterial and irrelevant if it wasn't offered in evidence? By ruling it out the Circuit Court of Appeals foreclosed considera-

tion of the very evidence which prompted reversal by the Court of Customs and Patent Appeals and thus did the very opposite of that required under *Morgan v. Daniels* (153 U. S. 120). While the Court in its opinion discusses that evidence such discussion is based upon the erroneously assumed question of fact in regard to the *identity* of Exhibit 1 and Exhibit NN.

Re top of p. 16 (Par. beginning "It was pointedly") Respondent's Brief, may we say that Respondent *tried* to prove that the blower part Exhibit 1 could not have been in existence in 1935 and failed, but (inadvertently we believe) established that such blower part came from a mold used in 1935, (Exhibit N, pp. 288, 312, 360, and Exhibit M-28) thus further proving Sperry's case.

A careful reading of "Appellee's Comments on Appellant's Petition for Rehearing" (being the appendix to Respondent's Brief), fails to show us any passage which would support the ruling by the Circuit Court of Appeals that Sperry Exhibit 1 came from a mold which had not been made earlier than 1936.

With regard to the disclaimer question, we believe that Respondent sidesteps our point. The second decision by the Court of Customs and Patent Appeals was handed down April 3, 1944 (141 F. (2d) 816). This present suit was filed by *Petitioner* on September 21, 1945 (R. p. 2). Respondent thus for *over a year* neither filed a disclaimer nor did anything to test the validity of its patent following the decision by the Court of Customs and Patent Appeals which accorded to Sperry the invention date in 1935, prior to Mayo's earliest claimed date.

Respondent thus did nothing following notice of invalidity for over a year and, in all likelihood, would have never done anything but assert validity (as it did in this suit in its counterclaim) without a further test thereof, if *Petitioner* had not brought this suit.

By the opinion of the Circuit Court of Appeals claim 6 (the broadest claim) has been held invalid and Respondent has *acquiesced in that ruling* (Respondent's Brief, top of p. 17). For thus failing to disclaim, for over a year, after the adverse ruling by the Court of Customs and Patent Appeals and now admitting that at least one claim was invalid, Respondent has placed himself squarely under the rulings of this Court with respect to disclaimers, and the patent is invalid *in toto*. *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646.

While we have not covered all of the inaccuracies in Respondent's Brief, we feel that we have sufficiently shown such brief as failing to in any way alter or disturb our contentions.

MAX W. ZABEL,

FOSTER YORK,

Counsel for Petitioner.